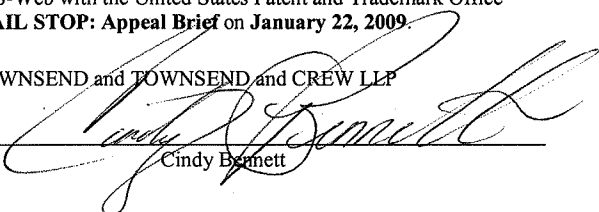


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PATENT
Attorney Docket No. 020375-042300US

TOWNSEND and TOWNSEND and CREW LLP

By: 

Cindy Bennett

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Paul Turgeon

Application No.: 10/680,081

Filed: October 6, 2003

For: METHODS AND SYSTEMS FOR
TRANSFERRING FUNDS TO
DIRECT-DEPOSIT ACCOUNTS

Confirmation No. 9924

Examiner: John H. Holly

Technology Center/Art Unit: 3694

APPELLANTS' BRIEF
UNDER 37 CFR §41.37

MAIL STOP: APPEAL BRIEF

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicants (hereafter "Appellants") hereby submit this Brief in support of its appeal from a final decision by the Examiner, mailed July 23, 2008 in the above-captioned case. Appellants respectfully request consideration of this appeal by the Board of Patent Appeals and Interferences (hereafter the "Board") for allowance of the above-captioned patent application.

An oral hearing is not requested at this time.

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1. REAL PARTY IN INTEREST

First Data Corporation, Englewood, Colorado is the real party in interest as the assignee of the above-identified application.

2. RELATED APPEALS AND INTERFERENCES

No other appeals or interferences are known that will directly affect, are directly affected by, or have a bearing on the Board decision in this appeal.

3. STATUS OF CLAIMS

Claims 1-13, 17-23 and 26-33 are currently pending in the application. All pending claims stand finally rejected pursuant to a final Office Action mailed July 23, 2008 (the "Office Action"). A response after final was filed on September 23, 2008. Subsequently, an Advisory Action was mailed on October 7, 2008 which affirmed all of the rejections from the Office Action. A timely notice of appeal was then filed on October 23, 2008.

The rejections of each of Claims 1-13, 17-23 and 26-33 are believed to be improper and are the subject of this appeal.

4. STATUS OF AMENDMENTS

All amendments have been entered. No amendments have been filed subsequent to the Office Action.

5. SUMMARY OF CLAIMED SUBJECT MATTER

In the following summary, Appellants have provided references to sections of the specification and/or drawings supporting the subject matter defined in the claims as required by 37 C.F.R. §41.37. The specification and/or drawings also include additional support for other exemplary embodiments encompassed by the claimed subject matter. Thus, these references are intended to be strictly illustrative in nature. Claims 1, 18 and 27 are the independent claims.

a. Independent Claim 1

A method for depositing funds in a deposit account which includes receiving a request to credit a specified amount to the deposit account at a node of a financial-services network that comprises a plurality of interconnected nodes. **(see Specification at page 2, paragraph 0006).** The request includes an indirect identification of the deposit account. **(see Specification at page 2, paragraph 0006).** The indirect identification is selected from the group consisting of a name of a holder of the deposit account, a name of a relative of the holder of the deposit account, a date meaningful to the holder of the deposit account, and a truncated portion of the holder of the deposit account's social security number. **(see Specification at page 3, paragraph 0009).**

The method further includes determining a direct identification of the deposit account from the indirect identification and from a nonpublic mapping of respective indirect identifications to respective direct identifications of respective deposit accounts. **(see Specification at page 2, paragraph 0006).** wherein the direct identification is selected from the group consisting of a primary account number for the deposit account, a routing number for the deposit account, and a transit number for the deposit account. **(see Specification at page 5, paragraph 0018).** Further, the method includes issuing an instruction to credit the deposit account with the specified amount in accordance with the determined direct identification. **(see Specification at page 2, paragraph 0006).**

b. Independent Claim 18

A computer-readable storage medium having a computer-readable program embodied therein for directing operation of a computational device comprised by a node of a financial-services network that comprises a plurality of interconnected nodes, the computational device including an input device, a communications system, a processor, and a storage device, is described. **(see Specification at page 3, paragraph 0010).**

The computer-readable program includes instructions for operating the computational system to deposit funds in a deposit account in accordance with the following. The computer-readable program includes instructions for receiving a request to credit a specified amount to the deposit account at a node of a financial-services network that comprises a plurality of interconnected nodes. **(see Specification at page 2, paragraph 0006).** The request includes an indirect identification of the deposit account. **(see Specification at page 2, paragraph 0006).** The indirect identification is selected from the group consisting of a name of a holder of the deposit account, a name of a relative of the holder of the deposit account, a date meaningful to the holder of the deposit account, and a truncated portion of the holder of the deposit account's social security number. **(see Specification at page 3, paragraph 0009).**

The computer-readable program further includes instructions for determining a direct identification of the deposit account from the indirect identification and from a nonpublic mapping of respective indirect identifications to respective direct identifications of respective deposit accounts. **(see Specification at page 2, paragraph 0006).** wherein the direct identification is selected from the group consisting of a primary account number for the deposit account, a routing number for the deposit account, and a transit number for the deposit account. **(see Specification at page 5, paragraph 0018).** Further, the computer-readable program includes instructions for issuing an instruction to credit the deposit account with the specified amount in accordance with the determined direct identification. **(see Specification at page 2, paragraph 0006).**

c. Independent Claim 27

A financial-services network comprising a plurality of interconnected nodes, with a first of such nodes comprising a computational device having an input device, a communications system, a storage device, a processor, and a memory coupled with the processor, is described. **(see Specification at page 11, paragraph 0035).** The memory comprises a computer-readable medium having a computer-readable program embodied therein for directing operation of the computational device. **(see Specification at page 3, paragraph 0010).**

The computer-readable program includes instructions for operating the computational system to deposit funds in a deposit account in accordance with the following. The computer-readable program includes instructions for receiving a request to credit a specified amount to the deposit account at a node of a financial-services network that comprises a plurality of interconnected nodes. **(see Specification at page 2, paragraph 0006).** The request includes an indirect identification of the deposit account. **(see Specification at page 2, paragraph 0006).** The indirect identification is selected from the group consisting of a name of a holder of the deposit account, a name of a relative of the holder of the deposit account, a date meaningful to the holder of the deposit account, and a truncated portion of the holder of the deposit account's social security number. **(see Specification at page 3, paragraph 0009).**

The computer-readable program further includes instructions for determining a direct identification of the deposit account from the indirect identification and from a nonpublic mapping of respective indirect identifications to respective direct identifications of respective deposit accounts. **(see Specification at page 2, paragraph 0006).** wherein the direct identification is selected from the group consisting of a primary account number for the deposit account, a routing number for the deposit account, and a transit number for the deposit account. **(see Specification at page 5, paragraph 0018).** Further, the computer-readable program includes instructions for issuing an instruction to credit the deposit account with the specified amount in accordance with the determined direct identification. **(see Specification at page 2, paragraph 0006).**

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Grounds of Rejection: The Office Action has rejected claims 1-13, 17-23 and 26-33 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of U.S. Patent Publication No. 2003/0126094 to Fisher et al. ("Fisher") in view of the cited portions of U.S. Patent No. 5,825,003 to Jennings et al. ("Jennings"). Office Action at p. 2.

7. ARGUMENT

THE REJECTION OF CLAIMS 1-13, 17-23 AND 26-33 UNDER 35 U.S.C. § 103(a) IS IMPROPER BECAUSE THE REFERENCES DO NOT DISCLOSE EACH AND EVERY ELEMENT OF THE CLAIMS

The Office Action has rejected claims 1-13, 17-23 and 26-33 under 35 U.S.C. § 103(a) as being unpatentable over Fisher in view of Jennings. In order for a claim to be unpatentable under 35 U.S.C. § 103(a), "the prior art reference (or references when combined) must teach or suggest all the claim limitations." *In re Vaech*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). For the reasons recited below, it is respectfully submitted that Fisher and Jennings, individually, or when combined, do not teach or suggest all of the claim limitations of the claims included in the Appendix of Claims.

A. Independent claims 1, 18, and 27 are patentable over Fisher in view of Jennings

Claims 1, 18, and 27 are independent claims from which all other pending claims depend. Claims 18 and 27 include nearly the same limitations and are rejected on the same grounds as claim 1. Accordingly, our initial arguments will focus on independent claim 1.

1. Fisher and Jennings fail to teach or suggest determining a direct identification of the deposit account from the indirect identification and from a nonpublic mapping of a plurality of respective indirect identifications to respective direct identifications of respective deposit accounts, wherein the direct identification is selected from the group consisting of a primary account number for the deposit account, a routing number for the deposit account, and a transit number for the deposit account

Appellants respectfully submit that Fisher discloses "provid[ing] a trusted third party service known as a Persistent Dynamic Payment Service (PDPS) which links a network on which online e-commerce transactions are being carried out between payers and merchants, typically a public network such as the Internet, and a private inter-bank payment network." (Fisher at paragraph 0025.) Fisher further discloses that "[i]t should also be noted that when the PDPS is referred to as a trusted third party... [that] it refers to the fact that it is a third party with respect to the payer and the merchant." (*Id.* at paragraph 0090.) Furthermore, in order to take advantage of the third party PDPS, a "cardholder registers with the PDPS and obtains a proxy

account number in the normal syntax of a debit card number" and "it is also possible to use a user-Id which is not in the syntax of a debit account number." The PSPD would "maintain a mapping of the user-ID against the preferred account number." (*Id.* at paragraphs 0135 and 0137.)

There are a number of reasons in which Fisher's implementation fails to teach or suggest, and even teaches away from the operations of claim 1, and similarly claims 18 and 27. One reason is that Fisher requires a third party (i.e., the PDPS) in order to implement its system. In contrast, claim 1 utilizes an already established financial network (*e.g.*, the deposit account's financial network) to map indirect information (*i.e.*, semi-private information) with direct information (*i.e.*, private account information). Hence, claim 1 does not require a third party entity as in Fisher, and in fact is specifically implemented to avoid the need for such an entity. This can be further demonstrated by Fisher's requirement that a cardholder register with the PDPS, and create a user-ID or receive a proxy account number. Claim 1 does not require the holder to register, create a user-ID, or receive a proxy account number. Claim 1 simply utilizes indirect information (*e.g.*, a name of a holder of the deposit account, a name of a relative of the holder of the deposit account, a date meaningful to the holder of the deposit account, a truncated portion of the holder of the deposit account's social security number, etc.) in order to protect the actual account number. In other words, in claim 1 the holder does not have to complete any special registration with a PDPS because claim 1 simply utilizes information in which the financial institution has already obtained from the holder.

Conversely, Fisher requires the holder to register with the PSPD, provide the PSPD with additional personal information, receive a proxy account number or create a user-ID, direct a merchant to interface with the PSPD by providing the proxy account number or user-ID, and then complete the transaction. In contrast, claim 1 utilizes the financial institution which issued the deposit account to the holder and not a third party PSPD. When a request with indirect information is received, the financial institution determines a direct identification of the deposit account (*e.g.*, the account number of the deposit account) from the indirect identification,

and if the mapping is correct the requested transaction is completed. No registration, no third party entity, no additional infrastructure or setup is required as is required by Fisher.

Furthermore, Jennings discloses "[a] system... for allowing funds to be transferred instantly to an account so that the funds are available to the beneficiary at the time they are sent." (Jennings at Abstract). Nonetheless, Jennings fails to teach or suggest those elements missing from Fisher.

2. Fisher and Jennings fail to teach or suggest issuing an instruction to credit the deposit account with the specified amount in accordance with the determined direct identification

Additionally, Fisher fails to teach or suggest the operation of "issuing an instruction to credit the deposit account with the specified amount in accordance with the determined direct identification" as recited by claim 1. In fact, the Office Action at page 3 concedes that "Fisher does not expressly disclose... issuing an instruction to credit the deposit account with the specified amount in accordance with the determined direct identification." Instead, the Office Action relies on Jennings as disclosing such a feature. The Office Action cites Jennings at col. 27, line 48 - col. 28, line 21 as disclosing this element of claim 1. However, Appellants are unable to find any disclosure in this cited section (or in Jennings as a whole) which teaches or suggests that the credit to the deposit account in the specified amount is in accordance with *the direct information*. As is recited in the claims, direct information is defined as "a primary account number for the deposit account, a routing number for the deposit account, or a transit number for the deposit account", while Jennings does disclose "authorizing a credit to the destination account in the requested amount", Jennings nonetheless, fails to teach or suggest that such a credit is in accordance with *determined direct information*. In fact, Jennings makes no mention of direct information or even determining such information. As such, Appellants submit that Jennings fails to teach or suggest that which is lacking from Fisher. Therefore, for at least these reasons, Appellants submit that claim 1, and similarly claims 18 and 27 are patentable over Fisher and Jennings, either individually, or when combined in any combination.

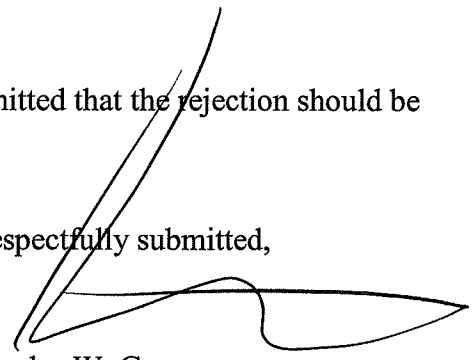
B. Dependent claims are not unpatentable over Fisher in view of Jennings

Dependent claims 2-13, 17, 19-23, 26, and 28-33 depend from independent claims 1, 18, and 27. Therefore, for at least the reasons mentioned above, and by virtue of their dependence on an allowable independent claim, Fisher and Jennings fail to disclose each and every limitation of claims 2-13, 17, 19-23, 26, and 28-33. As such, claims 2-13, 17, 19-23, 26, and 28-33 are patentable under 35 U.S.C. § 103(a) over Fisher and Jennings.

8. CONCLUSION

For these reasons, it is respectfully submitted that the rejection should be reversed.

Respectfully submitted,



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9. CLAIMS APPENDIX

1. (Previously Presented) A method for depositing funds in a deposit account, the method comprising:

receiving a request to credit a specified amount to the deposit account at a node of a financial-services network that comprises a plurality of interconnected nodes, wherein the request includes an indirect identification of the deposit account, wherein the indirect identification is selected from the group consisting of a name of a holder of the deposit account, a name of a relative of the holder of the deposit account, a date meaningful to the holder of the deposit account, and a truncated portion of the holder of the deposit account's social security number;

determining a direct identification of the deposit account from the indirect identification and from a nonpublic mapping of a plurality of respective indirect identifications to respective direct identifications of respective deposit accounts, wherein the direct identification is selected from the group consisting of a primary account number for the deposit account, a routing number for the deposit account, and a transit number for the deposit account; and

issuing an instruction to credit the deposit account with the specified amount in accordance with the determined direct identification.

2. (Original) The method recited in claim 1 wherein the financial-services network comprises a hub node and a plurality of ordinary nodes, wherein each ordinary node is in direct communication with the hub node.

3. (Original) The method recited in claim 2 wherein the node at which the request is received is the hub node.

4. (Original) The method recited in claim 1 wherein each of a plurality of the interconnected nodes is in direct communication with a second plurality of the interconnected nodes.

5. (Original) The method recited in claim 1 wherein the nonpublic mapping is maintained at the node at which the request is received.

6. (Original) The method recited in claim 1 wherein the nonpublic mapping comprises a plurality of nonpublic mappings of respective indirect identifications to respective direct identifications of respective deposit accounts, each such nonpublic mapping being maintained at a different node comprised by the financial-services network.

7. (Original) The method recited in claim 1 wherein receiving the request comprises receiving the request as routed from a second financial-services network that comprises a second plurality of interconnected nodes.

8. (Original) The method recited in claim 1 wherein issuing the instruction to credit the deposit account comprises transmitting the instruction for routing over a second financial-services network that comprises a second plurality of interconnected nodes.

9. (Original) The method recited in claim 1 wherein the network comprises an automatic-teller-machine network having least some nodes comprised by automatic teller machines.

10. (Original) The method recited in claim 1 wherein receiving the request comprises receiving the request as routed from an initiating automatic teller machine.

11. (Original) The method recited in claim 1 wherein the request does not include the direct identification.

12. (Original) The method recited in claim 1 wherein:
the request further includes an identification of a financial institution that maintains the deposit account; and
issuing the instruction to credit the deposit account comprises transmitting the instruction for routing to a node comprised by the financial institution.

13. (Original) The method recited in claim 1 wherein the node at which the request is received is comprised by a financial institution that maintains the deposit account.

14.-16. (Cancelled)

17. (Original) The method recited in claim 1 wherein at least a portion of the nonpublic mapping is encrypted.

18. (Previously Presented) A computer-readable storage medium having a computer-readable program embodied therein for directing operation of a computational device comprised by a node of a financial-services network that comprises a plurality of interconnected nodes, the computational device including an input device, a communications system, a processor, and a storage device, wherein the computer-readable program includes instructions for operating the computational system to deposit funds in a deposit account in accordance with the following:

receiving a request to credit a specified amount to the deposit account at the node with the communications system, wherein the request includes an indirect identification of the deposit account, wherein the indirect identification is selected from the group consisting of a name of a holder of the deposit account, a name of a relative of the holder of the deposit account, a date meaningful to the holder of the deposit account, and a truncated portion of the holder of the deposit account's social security number;

determining a direct identification of the deposit account with the processor from the indirect identification and from a nonpublic mapping stored on the storage device, the nonpublic mapping comprising a plurality of respective indirect identifications to respective direct identifications of respective deposit accounts, wherein the direct identification is selected from the group consisting of a primary account number for the deposit account, a routing number for the deposit account, and a transit number for the deposit account; and

issuing a deposit instruction with the communications system to credit the deposit account with the specified amount in accordance with the determined direct identification.

19. (Original) The computer-readable storage medium recited in claim 18 wherein the instructions for receiving the request comprise instructions for receiving the request as routed from a second financial-services network that comprises a second plurality of interconnected nodes.

20. (Original) The computer-readable storage medium recited in claim 18 wherein the instructions for issuing the deposit instruction to credit the deposit account comprise instructions for transmitting the instruction for routing over a second financial-services network that comprises a second plurality of interconnected nodes.

21. (Original) The computer-readable storage medium recited in claim 18 wherein the instructions for receiving the request comprise instructions for receiving the request as routed from an automatic teller machine.

22. (Original) The computer-readable storage medium recited in claim 18 wherein the request does not include the direct identification.

23. (Original) The computer-readable storage medium recited in claim 18 wherein:

the request further includes an identification of a financial institution that maintains the deposit account; and

the instructions for issuing the deposit instruction comprise instructions for transmitting the deposit instruction for routing to a node comprised by the financial institution.

24.-25. (Cancelled)

26. (Original) The computer-readable storage medium recited in claim 18 wherein at least a portion of the nonpublic mapping is encrypted.

27. (Previously Presented) A financial-services network comprising a plurality of interconnected nodes, wherein a first of such nodes comprises a computational device having an input device, a communications system, a storage device, a processor, and a

memory coupled with the processor, the memory comprising a computer-readable medium having a computer-readable program embodied therein for directing operation of the computational device, the computer readable program including:

instructions for receiving a request with the communications system from a second of such nodes to credit a specified amount to a deposit account identified with an indirect identification, wherein the indirect identification is selected from the group consisting of a name of a holder of the deposit account, a name of a relative of the holder of the deposit account, a date meaningful to the holder of the deposit account, and a truncated portion of the holder of the deposit account's social security number;

instructions for determining a direct identification of the deposit account with the processor from the indirect identification and from a nonpublic mapping stored on the storage device, the nonpublic mapping comprising a plurality of respective indirect identifications to respective direct identifications of respective deposit accounts, wherein the direct identification is selected from the group consisting of a primary account number for the deposit account, a routing number for the deposit account, and a transit number for the deposit account; and

instructions for issuing a deposit instruction with the communications system to credit the deposit account with the specified amount in accordance with the determined direct identification.

28. (Original) The financial-services network recited in claim 27 wherein at least one of the plurality of interconnected nodes comprises a hub node and some of the plurality of interconnected nodes comprise ordinary nodes.

29. (Original) The financial-services network recited in claim 28 wherein the hub node is the first node.

30. (Original) The financial-services network recited in claim 27 wherein each of a plurality of the interconnected nodes is in direct communication with a second plurality of the interconnected nodes.

31. (Original) The financial-services network recited in claim 27 wherein the nonpublic mapping is comprised by a plurality of nonpublic mappings, each such nonpublic mapping being maintained at a different node of the financial-services network.

32. (Original) The financial-services network recited in claim 27 wherein at least some of the interconnected nodes comprise an automatic teller machine ("ATM"), whereby the financial-services network is an ATM network.

33. (Original) The financial-services network recited in claim 27 wherein at least a portion of the nonpublic mapping is encrypted.

10. EVIDENCE APPENDIX

No additional evidence is provided.

11. RELATED PROCEEDINGS APPENDIX

No additional proceedings are in process.